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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,545	02/08/2002	James R. Hornsby	14333	9874

42173 7590 12/14/2004

LAW OFFICE OF RICHARD B. KLAR  
28 East Old Country Road  
Hicksville, NY 11801

EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/071,545

Applicant(s)

HORNSBY ET AL.

Examiner

Dmitry Suhol

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-34 is/are allowed.
- 6) ☒ Claim(s) 35-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 35, the limitation of "...wherein said enhanced function comprises at least enhancing a function which has already been activated" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not teach or imply that any function is activated prior to being enhanced, in fact paragraphs 128-130 imply that in order for the function to become active a card must be swiped through the device or a keying member must be inserted and if the function is used prior to becoming active points are deducted.

"...Using the attachment without so activating the car could either result in a penalty (i.e., a decrease in armor) or the attachment simply remains inactive..."

Regarding claim 40, the limitation of "...wherein at least one of said functions enhanced must have been activated prior to being enhanced" the same reasoning is applied as claim 35.

Regarding claim 41, the limitation of "...once the speed of the device has already been activated" the same reasoning is applied as claim 35.

Regarding claim 42, the limitation of "...once the mobility of the device has already been activated" the same reasoning is applied as claim 35.

Regarding claim 43, the limitation of "...once the defense of the device has already been activated" the same reasoning is applied as claim 35.

Regarding claim 44, the features encompassed by the limitation of "...said enhanced function further comprises performance of an additional function" can't be determined. The claim is dependent from claim 35, which limits the function to being one that is already active, therefore if the function is active it is unclear what makes it an additional function.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadfield (WO 95/30973) in view of Lorence et al '372. Broadfield discloses an amusement device containing most of the elements of the claims including with reference to claim 35, a body (element 2), a microprocessor operably coupled to a motor and configured to actuate the motor to propel an action (last sentence on page 2 and first sentence on page 3), a shape-specific key receiving device (read onto the coin operated slot described on page 2, first sentence), a swipe card reader (read onto the credit card swipe module described on page 2, last paragraph) operably coupled to a microprocessor (page 2, last paragraph) where it is considered that since the device receives data from a swipe card and in turn movement and visual effects are initiated/enhanced (considered to be an enhanced function of the device) and that the data presents enhancement data. At least two movable elements movably coupled to the body, as required by claim 37, are read onto the hydraulic elements 3 and 4. Couplings attaching the hydraulic elements, as required by claim 37, are inherent in the device since without them the device would not function. The body and device being reconfigurable, as required by claims 38-39, is described on pages 2-3, where it is considered that since the device moves up and down the different position provide different configurations of the device. The function being enhanced comprising one of more mobility, speed and defense, as required by claims 40-43, is described at pages 2-3, where it is considered that mobility, speed and defense are enhanced since prior to the swiping of the card the device does not move and a moving target is harder to hit with a projectile than a stationary target. An enhanced function being an additional

function, as required by claim 44, is read onto the audio output of the device as described at page 3 in the last paragraph.

Regarding the limitation of an enhanced function comprising a function which has already been activated, as required by claim 35 and 40, it is the position of the examiner that Broadfield discloses functions that are already active but enhanced by the swipe card, for example the video function is already active as taught at page 3 in the middle of the first full paragraph which clearly states that in a "default" setting image segments are displayed. Furthermore, it is the position of the examiner that while the device is in the "default" setting all of its functions are active, in other words although the device might not be in motion the device and all of its associated functions have been activated (an analogous situation may be a car with the ignition turned on but the transmission being in park or neutral).

Broadfield fails to explicitly teach a motor associated with a body as required by claim 35, however Lorence discloses an amusement device, like that of Broadfield, which teaches the use of a motor (52) in order to actuate a hydraulic support (30) which in turn moves the body (24) of the device. Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have provided a motor with the device of Broadfield for the purpose of actuating the hydraulic elements 3 and 4.

***Allowable Subject Matter***

Claims 25-34 are allowed.

Claim 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed September 10, 2004 have been fully considered but they are not persuasive. Applicants argue that the limitation of "...at least enhancing a function of the amusement apparatus which has already been activated" defines claim over the prior art of record. In response the examiner points to the reasoning in the above rejection reiterates that Broadfield discloses functions that are already active but enhanced by the swipe card, for example the video function is already active as taught at page 3 in the middle of the first full paragraph which clearly states that in a "default" setting image segments are displayed, however when a card is swiped the video is enhanced whereby it no longer shows video segments but rather the entire program. The examiner further points out that while the device is in the "default" setting all of its functions are active, in other words although the device might not be in motion the device and all of its associated functions have been activated (an analogous situation may be a car with the ignition turned on but the transmission being in park or neutral).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-273-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

Dmitry Suhol  
Dmitry Suhol